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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/795,970

03/08/2004

Michael Conte

99823-00002

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27614 7590 12/12/2007
MCCARTER & ENGLISH, LLP
FOUR GATEWAY CENTER
100 MULBERRY STREET
NEWARK, NJ 07102

EXAMINER

GRAY, PHILLIP A

ART UNIT.

PAPER NUMBER

3767

MAIL DATE

DELIVERY MODE

12/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/795,970

Applicant(s)

CONTE, MICHAEL

Examiner

Phillip Gray

Art Unit

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/20/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-12 and 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-12 and 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicant's communication of 9/20/2007.

Currently amended and newly added claims 1, 4-8, 10-12 and 22-27 are pending and stand rejected below.

Response to Arguments

Applicant's arguments with respect to claims 1, 4-8, 10-12 and 22-27 have been considered but are moot in view of the new ground(s) of rejection.

It is examiners position that Staebler would be fully capable of satisfying the claim language of "means in the cap holding device for selectively retaining or releasing the cover from engagement within the cap holding device". This limitation was in the previously cancelled (and rejected) claim 9. It is examiners position that Staebler would be fully capable of this function and operation and has means for carrying this out. While the elements in the claim expressed as a means for performing a specified function must be construed as covering the corresponding structure described in the specification and equivalents thereof, there is no requirement that the prior art reference suggest that such element actually be intended to perform the recited function. It is examiners position that the Staebler reference is capable of performing the function described in the claim limitation. As evidence of this examiner references the Gach (US 4,890,734) reference and compare Gach figure 3 with Staebler figure 4, and note Gach paragraphs at column 3, lines 20-45. It discusses that this needle cover arrangement is "selectively" retaining or releasing from the cap holding device. Therefore it is

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examiners position that Staebler is capable and comprises this means for "selectively retaining or releasing" the cover.

Concerning the amendments to claim 22, it is examiners position that Staebler's protrusions (identified below), the engaging part of the protrusions which engage the recess of the hub, extend "radially inward of the cover". Further it is examiners position that the cover contains "handles" (the area of the Staebler cover which contact or engage element 16 for example), which could be "substantially oval" (as if taken in a viewed cross section taken down the vertical of figure 4).

Concerning the remote "actuator" in the applicant's remarks, during examination, claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-1405, 162 USPQ 541, 550-51 (CCPA 1969), and under this analysis, examiner is of the position that the actuator, (the shield, element, or human operating) would be considered "not direct, primary, or proximate; not directly involved or influential" in the operation, and thus "remotely" operating.

The elements disclosed in the prior art of record are fully capable of satisfying all structural, functional, spatial, and operational limitations in the amended claims, as currently written, and the rejection is made and proper. See rejection discussion below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 10, 12 and 22-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Staebler (U.S. Patent Number 4,742,910). Staebler discloses a hypodermic needle sheath holder. Staebler discloses a safety syringe and cap holding device (fig 1-4) comprising a syringe (35) with needle (34) and hub (40), a cover (28), a cap holding device (10) and this system is fully capable of the means for disengaging the cover from the hub and retaining the cover in the cap holding device to allow the syringe and needle assembly to be withdrawn from the cap holding device with the injection end uncovered while the cover remains in the cap holding device (operation of Staebler as described in columns 1-3).

It is examiners position that the hub has an annular recess about the hub and the cover comprises at least a pair of protrusion for engagement with the recess of the hub (as in fig.4, upper and lower protrusions on opening of cover 28 which contact annular recess space on hub 40. Further Staebler comprises a remotely actuated linkage system (as shown in figures 1-4 and by actuator elements 10 or 22 or actuated by operator themselves) with hooks (24) for engaging handles on the cover (area contacted by hooks on cover 28 and also area near 32) for disengaging the protrusions away from the recess to disengage the cover from the hub (as in the operation described in columns 1-3). Further the cover/cap holding means can selectively retain and release the cover (cap) and this would include the tip of the cover (cap)

(engagement means near 32). Further the base of the Staebler cap holding device base is weighted.

Concerning claim 22, it is examiners position that cap/cover 28 include "handles" which correspond to internal facing protrusions (see claim objection above). Further examiner is reading the last paragraph of the claim 22 as a "means for" claim limitation and is of the position that Staebler discloses this cap disengaging operation/function and is also in not exactly like the applicants "means for" the prior art is an equivalent thereof.

Concerning claim 27 it is examiners position that the actuator (such as element 22) is not integrally attached to the housing (12) since they are formed of two separate pieces (as in figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7,8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Staebler.

Concerning claims 7,8,11, Staebler discloses the claimed invention except for a plurality of solenoids, which actuate the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add a plurality of solenoids, which actuate the device, since it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192 (CCPA 1958).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571) 272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

